

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/288,757 04/08/99 HOROWITZ

F 991057

EXAMINER

TM02/0827

MAX SHAFTAL
SHAFTAL AND ASSOCIATES, LTD.
300 SOUTH WACKER DR., SUITE 3000
CHICAGO IL 60606

RIMELL, S

ART UNIT

PAPER NUMBER

2166

DATE MAILED:

08/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/288,757

Applicant(s)

HOROWITZ ET AL.

Examiner

Sam Rimell

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-3, 5, 7-9, 12, 13, 16, 19, 21 and 24-25 are rejected under 35 U.S.C. 102(a) as being anticipated by Spurgeon ('129).

The reasons for this rejection were set forth in the office action of 12/15/00 and are hereby incorporated by reference. With respect to newly added claims 24-25, it is observed that the network of Spurgeon incorporates the Internet, which incorporates both transient and permanent networks. Transient networks would be dial up modems connected to the Internet. Permanent networks would be the networks of hard wired switches carrying Internet data. Both of these are inherent features of the Internet.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 11, 14, 15, 20, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spurgeon ('129).

Claims 4, 6 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spurgeon ('129) in view of Moore et al. ('759).

Remarks

Applicant's primary argument against the application of the Spurgeon reference is that Spurgeon allegedly does not disclose real time processing and instantaneous return of data. To this effect, applicant states (at page 7, fourth paragraph):

"Real time, as used herein, refers to the interactive input of a request for information and the instantaneous response that answers that request-not just a message that the request was received or that an answer will follow".

However, this definition of real time, requiring instantaneous response to queries is not how the term "real time" was defined in the disclosure. The term "real time" is repeatedly used in the disclosure to express the concept that the physician accessible data is constantly updated. so that when it is accessed, it provides accurate (i.e. real time) information. This definition for "real time" occurs three times in the disclosure:

"In a preferred embodiment, the method further includes the step of updating the data so as to provide accurate data in real time." (page 5, lines 7-8 of applicant's disclosure).

"Thus, the updating means operates on a 24 hour basis, and permits continuous updating of the data stored in the system. As a result, throughout the operation of the system, the operator is provided with accurate, dependable information pertaining to a subscriber on a real time basis" (page 11, lines 20-23 of applicant's disclosure).

"In addition, since the information is continuously updated, the information received by the system operator at the dental care provider accurate and up to the minute information. Thus, the invention places the information, in real time, which has been previously available to the

dental care provider only through a telephone call with the carrier..." (page 12, lines 3-8 of applicant's disclosure).

Thus, the term "real time" has nothing to do with an instantaneous response to a query, but is related to the preparation of accurate, updated data.

This concept of providing accurate, updated data is exactly what is disclosed by Spurgeon. The Spurgeon reference states that:

Push technology ensures that the data on the provider interface is always kept up to date, because the data is pushed out to the provider interface computer into a provider database located therein, rather than requiring the provider to pull the data down from the information exchange server".

This statement matches the qualifications for accurate (i.e. real time) data which is described in applicant's disclosure. Accordingly, Examiner does not find that Spurgeon lacks the teaching of "real time" as suggested by applicant.

Since the concept of real time data is already described by the Spurgeon reference, it does not need to be re-taught by secondary references such as Moore et al.

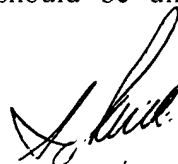
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 2166

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.

A handwritten signature in black ink, appearing to read 'S. Rimell', is positioned above the printed name and title.

Sam Rimell
Primary Examiner
Art Unit 2166